

REMARKS

Applicant has carefully reviewed the Office Action dated February 9, 2010. Claims 1-16, 18-33 and 35 are pending in the application. Applicant has amended Claims 1-2, 5-6, 8, 19-20, 23-25, and 33 to more clearly point out the present inventive concept.

Applicant wishes to thank the Examiner for granting the interview of May 10, 2010 to discuss the Office Action issued by a previous Examiner. In the interview, Applicants discussed the claim construction of Claim 1 against the cited prior art. In the Interview Summary the Examiner acknowledged that U.S. Patent No. 5,978,773 to *Hudetz et al.* (hereinafter “*Hudetz*”) does not teach the claimed “portable triggering device” of Claim 1. The Examiner further indicated that he would determine if U.S. Patent No. 6,297,727 to *Nelson* (hereinafter “*Nelson*”) taught such a feature and whether it is obvious to combine *Hudetz* and *Nelson* to disclose the limitation with the consideration of the whole claim.

Double-Patenting

Claims 1-16, 18-33 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of co-pending application no. 11/877,510. Claims 1-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 7,386,600. Upon notice of allowable subject matter, Terminal Disclaimers will be submitted with respect to Application No. 11/877,510 and U.S. Patent No. 7,386,600.

Claim Rejections – 35 U.S.C. § 103

Claims 1-12, 16-18, 19-30, 33, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 5,978,733 to *Hudetz et al.* (hereinafter “*Hudetz*”), U.S. Patent No. 6,297,727 to *Nelson* (hereinafter “*Nelson*” and U.S. Patent No. 5,905,248 to *Russell et al.* (hereinafter “*Russell*”). Claims 13-15 and 31-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Hudetz-Nelson-Russell* combination and further in view of U.S. Patent No. 5,640,193 to *Wellner* (hereinafter “*Wellner*”). These rejections are respectfully traversed with respect to the claims as currently presented.

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Regarding Claim 1 of the present application, the Office Action asserts that *Hudetz* discloses “an activation system.” Applicant respectfully submits that *Hudetz* fails to teach or suggest “an activation system” as recited in Claim 1. The “activation system” of Claim 1 “in response to the portable triggering device being within a predetermined proximity of an activation system...” and “...interacting with the portable triggering device...” “caus[es] the unique code from the triggering device to be extracted therefrom through activation thereof by the activation system...” There is no teaching or suggestion of such an “activation system” in *Hudetz*. On page 5 of the Office Action it is asserted that column 11, lines 28-37 of *Hudetz* describes “connecting the activation system to the remote location.” Applicant respectfully disagrees that *Hudetz* describes an “activation system.” *Hudetz* describes that if a user wants access to a remote server 128, he or she scans a bar code 136 using a bar code reader 120. Applicant respectfully submits that the bar code reader of *Hudetz* is not an “activation system” as recited in Claim 1. A bar code reader merely scans a bar code to obtain a UPC code. A bar code reader does not “activate” a bar code as a bar code is a passive device which remains passive during the scanning procedure. The bar code reader does not and can not cause a bar code to output a unique code when the bar code reader is proximate to the bar code. The bar code is a passive device that cannot be “caused” to do anything. Accordingly, Applicant submits that *Hudetz* fails to teach or suggest the “activation system” of Claim 1.

As admitted on page 5 of the Office Action, *Hudetz* fails to disclose “when the portable trigger device is within a predetermined proximity of an activation system, the activation system interacting with the triggering device causing the unique code from the triggering device to be extracted therefrom through activation thereof by the activation system, the activation system interfaced with a network and physically separate from the triggering device.” The Office Action then relies on the RFID system of *Nelson* to remedy this deficiency of the passive barcode system of *Hudetz*. To support this combination, the Office Action asserts on page 5 that Figure 8, column 6, lines 28-33, column 7, lines 17-28 and column 12, lines 11-21 of *Hudetz* “suggests exploration of art and/or provided a reason to modify the method with the portable triggering device feature.” The Office Action further states on page 8 that “*Hudetz* suggests incorporation of various input devices, including RF devices. Therefore, the artisan of ordinary skill in the art would look to the RF transponder identification system of *Nelson*.” Applicant

respectfully disagrees and submits that the cited paragraphs fail to suggest the combination of *Hudetz's* passive system with the RFID system of *Nelson* as further discussed below.

UPC symbol 46 provides a machine-readable number that uniquely identifies a particular product and its manufacturer. This is useful at the retail point-of-sale, where purchase of a particular item is recorded by scanning the item's bar code symbol. (*Hudetz*, column 6, lines 28-33)

The first cited paragraph of *Hudetz* as reproduced above simply describes a use for a passive UPC symbol.

Each record 62-68 of database 60 associates a UPC product identification number (contained in fields 70 and 72) with a particular Internet URL and narrative description (contained in fields 74 and 76, respectively). The association is based on selected criteria. In this case, the criteria is the existence of a Web resource sponsored by the manufacturer of the product identified by the UPC number in fields 70 and 72. (If no such resource exists, then the particular product identifier can be omitted from database 60). Other criteria can be used. For example, the association could be based on the existence of a Web site simply referring to or relating to the product. (*Hudetz*, column 7, lines 17-28)

The second cited paragraph of *Hudetz* as reproduced above simply describes associating a passive UPC product identification number with information in a database. The criteria upon which the associations are based may change, but the UPC product identification number is still represented by a passive device.

The foregoing embodiment is just one example. Many alternatives are possible. For example, in lieu of a bar code scanning device, a card reader could be employed. The card reader would read a magnetic stripe affixed to a card or other printed matter. The card would contain human-readable information about a network resource, and the magnetic strip would contain the resource's numeric or mnemonic address in machine-readable format. Alternatively, a RF data collection scanner or CCD scanning system could be used. Bar code symbol 126 could also be associated with specific commands such as "forward", or "back," or command sequences used to access information. (*Hudetz*, column 12, lines 11-21)

While the third cited paragraph of *Hudetz* as reproduced above describes alternatives, these alternatives are all passive. Both the RF data collection scanner (i.e., an extender device that scans a barcode using conventional scanning methods and then transmits the scanned information via an RF signal rather than a cable) and the CCD scanning system deal with passive codes that must be scanned as described elsewhere in *Hudetz*. Any teaching or suggestion of the use of “RF devices” by *Hudetz* is limited to the RF transmission of already scanned data rather than transmitting the scanned data by a cable. *Hudetz* contain no teaching or suggestion of replacing the bar code of *Hudetz* with a portable triggering device that is caused to output a unique code when it is proximate to an activation system.

Accordingly, Applicant submits that even if the cited paragraphs of *Hudetz* suggest exploration of art and/or provide a reason to modify the method with the portable triggering device feature, such suggestions are limited to passive systems as described in *Hudetz* as there is no suggestion of “causality.”

The barcode system of *Hudetz* does not and cannot be “caused” to output a unique code in response to it being within a predetermined proximity to an activation system as required by Claim 1 since *Hudetz* does not “activate” anything and, thus, there is no causative action or interaction with the barcode. The transponder identification and record assembly 10 of *Nelson* is substituted in the Office Action for the bar code of *Hudetz*. Applicant submits that the proposed primary combination of *Hudetz* and *Nelson* is flawed. For example, *Hudetz* describes various scenarios in which a barcode may be scanned from “ordinary articles of commerce” (see, e.g., Abstract). However, if combined with the RFID system of *Nelson*, there is no teaching or suggestion as to how a particular barcode would be scanned if multiple barcodes are in range. In other words, if each article of commerce contains a barcode as proposed by *Hudetz*, how will the RFID system of *Nelson* recognize which particular code is desired by a user for scanning? How would a user choose a particular barcode? In *Hudetz*, such differentiation between various barcodes that are in close proximity is not required other than by scanning of the proper barcode by the user.

Applicant submits that one skilled in the art would not be motivated to combine the two systems of *Hudetz* and *Nelson*, each of which performs a specific function in order to fulfil a

specific purpose, because such a combination would not result in an advantage to either system. *Hudetz* has no need for “allow[ing] users to access published locations without having to manually enter the published address through input devices” as stated on page 6, paragraph 2 of the Office Action, because a user is personally selecting a particular barcode and has no need for automatic entry of bar codes. *Nelson*’s RFID has no need of *Hudetz*’s barcode as that defeats the purpose of the invention of *Nelson*. Applicant submits that one skilled in the art would not be motivated to combine the *Hudetz* and *Nelson* references as described in the Office Action. Accordingly, Applicant submits that it would not be obvious for one skilled in the art to integrate the RFID of *Nelson* with the bar code scanning device of *Hudetz*. The remaining reference of *Russell* does not remedy these deficiencies of the *Hudetz* and *Nelson* combination.

Further regarding Claim 5, the Office Action asserts that column 4, lines 59-66 and column 6, lines 9-25 of *Nelson* discloses “wherein the portable triggering device further includes a unique transponder identification code stored therein, the unique transponder identification code being exclusively associated with that portable triggering device.” Applicant respectfully disagrees. The cited portions of *Nelson* appear to contain no teaching or suggestion that the RFID tag of *Nelson* includes “a unique code” associated with “location information corresponding to a location of a web page on a remote location disposed on the network...”, as well as a “unique transponder identification code exclusively associated with that portable triggering device” as recited in Claims 1 and 5.

Additionally, Claims 1-4, 8, 9, 10-11, 16, 18-22, 24, 26, 28-29, 33 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,446,871 to *Buckley et al.* (hereinafter “*Buckley*”) and U.S. Patent No. 5,903,225 to *Schmitt et al.* (hereinafter “*Schmitt*”).

Applicant submits that the proposed combination of *Buckley* and *Schmitt* is flawed. For example, *Buckley* describes various scenarios in which a barcode may be scanned from various surfaces of a periodical (see, e.g., column 4, lines 41-47). However, even if combined with the system of *Schmitt*, there is no teaching or suggestion as to how a particular barcode would be scanned. If each article or advertisement in a periodical contains such a code as proposed by *Buckley*, how will the “access triggering device” of *Schmitt* recognize which particular code is to be scanned if there are multiple codes within range?

Applicant submits that one skilled in the art would not be motivated to combine the two systems of *Buckley* and *Schmitt*, each of which performs a specific function in order to fulfil a specific purpose, because such a combination would not result in an advantage to either system. *Buckley* has no need to eliminate the scanner by having the triggering device automatically communicate with the activation system and has no need to prevent a user from going through the inconvenience of locating or manipulating the scanning system as proposed in the Office Action (page 13), because the invention described in *Buckley* “facilitates a user's ability to retrieve information on the Internet or other broad-based computer communication network using an altered version of a commonly-carried writing instrument.” (*Buckley*, column 3, line 67 – column 4, line 3). In other words, *Buckley* alleviates these issues by presenting the various embodiments described therein, most notably as an easily portable pen. In fact, such automatic communication may be disadvantageous to a user when multiple barcodes are present or when the user does not want to scan a barcode, and such automatic communication may be prevented by requiring the user to scan the barcode as described in *Buckley*. *Schmitt* has no need of *Buckley*'s barcode scanning system, as *Schmitt* incorporates a fingerprint scanner and an access triggering device in a system (see, e.g., *Schmitt*, Abstract) that has no need to distinguish between closely located barcodes such as are found in the periodicals of *Buckley*. Accordingly, Applicant submits that one skilled in the art would not be motivated to combine the *Buckley* and *Schmitt* references as described in the Office Action.

With respect to specific language in the Office Action, *Buckley*, like *Hudetz* in the previous discussion, is directed to a passive device. As admitted in the Office Action on page 12, *Buckley* fails to disclose “a portable triggering device having a unique code stored therein and causing extraction of the unique code from the triggering device with an activation system operable to interface with the portable triggering device when the portable triggering device is proximate to the activation system.” The Office Action then relies on the access triggering device (i.e., a passive transponder) of *Schmitt* to remedy this deficiency of *Buckley*. To support this combination, the Office Action states that “*Buckley* suggested exploration of art and/or provided a reason to modify the method and apparatus with other features such as wireless and portable triggering device (column 4, lines 56-61, column 5, lines 49-55, column 11, lines 27-37, column 12, lines 52-58).” However, as described below, Applicant submits that the cited

paragraphs fail to suggest the combination of *Buckley's* passive system with the access triggering device of Schmitt.

Alternatively, the pen can communicate directly with the computer. In other words, no physical connection, e.g., no data well, is used. Instead wireless communication technology, such as an infra-red link or other electromagnetic link, is used to allow the pen to communicate directly with a computer. (*Buckley*, column 4, lines 56-61)

The first cited paragraph as reproduced above describes means by which the pen (i.e., the scanner) can communicate with the system. This text does not describe any type of communication between the object being scanned (i.e., a barcode) and the scanner.

Alternatively, the data reader 16 can communicate directly with a personal computer using wireless communication technology, e.g., a radio-frequency (RF) link, an infrared link, or other electromagnetic link, as described further below. In other words, circuits in the data reader both read the code associated with an article and communicate with a personal computer or other electronic device. (*Buckley*, column 5, lines 49-55)

The second cited paragraph as reproduced above again describes means by which the data reader (i.e., the scanner) can communicate with the system. As with the first cited paragraph, this text does not describe any type of communication between the object being scanned (i.e., a barcode) and the scanner.

In embodiments of the present invention described above, a code reader is incorporated into a pen. In other embodiments, the code reader may be incorporated in other writing instruments, or may be incorporated in some other, preferably portable, device such as a watch, cellular phone, etc. In still other embodiments, the code reader may be a stand-alone portable device designed to easily fit within a pocket or brief case and may be even incorporated into a laser-pointer-type shaped device which may be attached to a user's keychain. (*Buckley*, column 11, lines 27-37)

The third cited paragraph as reproduced above simply describes different physical embodiments of the code reader. As with the two previously cited paragraphs, this text does not describe any type of communication between the object being scanned (i.e., a barcode) and the scanner.

AMENDMENT

Having thus described at least one illustrative embodiment of the invention, various alterations, modifications and improvements will readily occur to those skilled in the art. Such alterations, modifications and improvements are intended to be within the scope and spirit of the invention. Accordingly, the foregoing description is by way of example only and is not intended as limiting. (*Buckley*, column 12, lines 52-58)

The fourth cited paragraph as reproduced above simply states that “various alterations, modifications and improvements” may be made, but fails to actually suggest any such modifications, much less one that would involve a triggering device as required by Claims 1 and 19.

Accordingly, Applicant submits that even if the cited paragraphs of *Buckley* suggest exploration of art and/or provide a reason to modify the method with the a triggering device feature, such suggestions are limited to passive systems as described in *Buckley*.

In other words, as recognized in the Office Action, the passive tag of *Buckley* does not and cannot interact or be activated as required by Claims 1 and 19. Therefore, the access triggering device of *Schmitt* is substituted in the Office Action for the passive tag of *Buckley*. The Office Action (page 13) further states that “[i]t would have been obvious to one of ordinary skill in the art ... to modify the method and apparatus of *Buckley* with the teachings of *Schmitt* to include a portable triggering device of a user having a unique code stored therein in order to eliminate the cumbersome scanner because the triggering device would communicate with the activation system automatically when the user is in contact with the activation system.... In addition, the portable triggering device would prevent the users [from going] through the inconvenience of locating or manipulating the scanner system.” However, nowhere does *Buckley* indicate that such modifications are desirable. In fact, as described previously, *Buckley* describes in detail various embodiments that alleviate such concerns, and such modifications may actually complicate the operation desired in *Buckley* without providing any advantages.

In view of the foregoing, Applicant submits that independent Claims 1 and 19 are allowable over the cited references. Claims 2-16, 18, 20-33, and 35 depend from their respective independent Claims 1 and 19 and are allowable for at least the same reasons.

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/RPXC-25,356 of HOWISON & ARNOTT, L.L.P.

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